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REMARKS

Claims 1-27 are pending in the present Application. Claim 9 has been amended to incorporate the limitations of Claim 15. Claim 16 has been amended to depend from Claim 9. Claim 15 has been canceled, leaving Claims 1-14 and 16-27 for consideration upon entry of the present amendment. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has asserted that the phrase "comprising chloride, sulfate, phosphate or a combination of two or more of the foregoing ionic species in an amount of zero to about 100 parts per billion" (Claim 1) is indefinite because it is unclear whether the recited ionic species is present "or whether applicant's language is directed to the combination thereof" (Office Action, page 12). Applicants respectfully disagree.

Applicants earnestly assert that one of ordinary skill in the art would readily understand that the recited language describes an amount which begins at and includes zero. Thus it is clear that chloride may be present in an amount of zero to about 100 parts per billion, sulfate may be present in an amount of zero to about 100 parts per billion, phosphate may be present in an amount of zero to about 100 parts per billion, or a combination of two or more of the ionic species (chloride, sulfate or phosphate) may be present in an amount of zero to about 100 parts per billion.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-27 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by 6,486,294 to Brack et al (Brack). Applicants respectfully traverse this rejection.

Brack discloses a poly(carbonate-co-ester) block copolymer and a method of making the poly(carbonate-co-ester) block copolymer. The method involves mixing a polyester prepolymer in a reaction mixture comprising an aromatic dihydroxy compound, a carbonic

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acid diester and a catalyst, bringing the reaction mixture to thermal equilibrium and removing the volatile component from the reaction mixture (Col. 1, line 49 to Col. 2, line 3). The examples disclose that the copolymer product may be purified by dissolving it in chloroform and precipitating with methanol (Col. 6, lines 42-45). Brack makes no mention of the ionic species content or organic compound content of the resulting poly(carbonate-co-ester) block copolymer as is instantly claimed. Furthermore, Brack is silent with regard to the ionic species content and organic compound content of the starting monomers.

The Examiner has asserted "the methylene chloride solution would impart ionic species to the mixture to form zero to about 100 parts per billion based on the total weight of the polycarbonate (Office Action, page 3). Applicants find no mention of methylene chloride in this reference and assume that the Examiner intended to refer to chloroform. Regardless, Applicants respectfully request that the Examiner provide support for the assertion that dissolution in chloroform followed by precipitation would result in a polycarbonate meeting the claimed limitations.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Applicants respectfully assert that Brack does not teach each and every element of independent Claim 1 or Claim 9. Brack fails to disclose a polycarbonate composition comprising chloride, sulfate, phosphate or a combination of two or more of the foregoing ionic species in an amount of zero to about 100 parts per billion based on the total weight of the polycarbonate; and phenol, carbonic diester, aromatic dihydroxy compound or combination of two or more of the foregoing organic compounds in an amount of zero to about 500 parts per million by weight based on the total weight of the polycarbonate as recited in Claim 1. Similarly, Brack does not disclose that the aromatic dihydroxy compound used in making the polycarbonate, as described in Claim 9, comprises up to about 100 parts per billion by weight metal based on the total weight of the aromatic dihydroxy compound.

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Claim Rejections Under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Brack in view of U.S. Patent No. 6,271,290 to Inoue et al (Inoue). Applicants respectfully traverse this rejection.

Brack has been discussed above. Inoue has been cited for its teaching with regard to the addition of a sulfur containing acidic compound. Inoue does not teach or suggest the ionic species content or organic compound content of the polycarbonate composition as is instantly claimed. Furthermore, Inoue is silent with regard to the ionic species content and organic compound content of the starting monomers. As such Inoue does not remedy the deficiencies of Brack.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Because the combination of Brack and Inoue fails to teach each and every element of Claim 24, Applicants respectfully assert that Claim 24 is non-obvious.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Brack in view of U.S. Patent No. 6,608,165 to Funakoshi et al. (Funakoshi). Applicants respectfully traverse this rejection.

Funakoshi has been cited for its teaching with regard to metal impurities. Funakoshi however does not teach or suggest any limitations with regard to the ionic species content and organic compound content in the polycarbonate composition as well as the ionic species content in the starting monomers. Accordingly, the combination of Brack and Funakoshi does not contain an adequate basis for a prima facie case of obviousness.

Claims 21-23 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Brack in view of U.S. Patent No. 6,509,435 Kageyama et al (Kageyama). Applicants respectfully traverse this rejection.

Kageyama has been cited for its teaching with regard to an ester exchange catalyst. Kageyama does not teach or suggest any limitations with regard to the ionic species content

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and organic compound content in the polycarbonate composition as well as the ionic species content in the starting monomers. Accordingly, the combination of Brack and Kageyama do not contain an adequate basis for a *prima facie* case of obviousness.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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